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ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED

MAR 26 2010

OFFICE OF PETITIONS

In re Application of :
Brian Labrec : DECISION ON APPLICATION
Application No. 10/677,092 : FOR
Filed: September 30, 2003 : PATENT TERM ADJUSTMENT
Atty. Dkt. No. 38820-534001US :
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)," filed on December 17, 2009. Applicants request that the initial determination of patent term adjustment be corrected from eighteen (18) days to forty-eight (48) days. Applicants additionally state that the correction is requested in view of the decision in Wyeth v. Dudas, (D.D.C. 2008). As applicant raises the issue of delay under 37 CFR 1.702(b), the petition will be treated as a petition requesting correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

The application for patent term adjustment is **GRANTED to the extent indicated.**

The Office has updated the PALM and PAIR screens to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **FORTY-EIGHT (48)** days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee

is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

To the extent the application requests reconsideration under 37 CFR 1.705(b), the petition is **GRANTED**.

On September 21, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 18 days. The period of adjustment was 285 days of PTO delay and 267 days of applicant delay.

On December 17, 2009, the subject application for patent term adjustment was timely filed.²

Applicants state that a period of reduction of 11 days for applicant delay should be entered pursuant to 37 CFR 1.704(c)(8), for the filing of a supplemental paper (IDS) on July 1, 2005, 11 days after the filing of a reply on June 20, 2005.

Upon review, applicants are correct. A review of the record reveals that on July 1, 2005, 11 days after the filing of a reply on June 20, 2005, an IDS was filed. The IDS was not accompanied by the statement set forth in 37 CFR 1.704(d). Therefore, a period of reduction of 11 days for applicant delay will be entered.

Applicants state that a period of reduction of 14 days for applicant delay should be entered pursuant to 37 CFR 1.704(c)(8) for the filing of a supplemental paper (IDS) on October 24, 2006, 14 days after the filing of a reply on October 10, 2006.

Upon review, applicants are correct. A review of the record reveals that on October 24, 2006, 14 days after the filing of a reply on October 10, 2006, an IDS was filed. The IDS was not accompanied by the statement set forth in 37 CFR 1.704(d). Therefore, an additional period of reduction of 14 days for applicant delay will be entered.

Applicants assert that duplicate periods of both Office and applicant delay have been entered. In particular, applicants assert duplicate periods of reduction for applicant delay of 61 days on November 20, 2007; of 4 days on April 21, 2008, and of 33 days on September 15, 2008, respectively, were entered. Further, applicants assert a duplicate period of adjustment for Office delay of 43 days was entered on February 27, 2009.

²A review of PALM records indicates that the issue fee was paid on December 18, 2009.

Upon review, applicants are correct. Duplicate periods of applicant delay of 61 days, 4 days, and 33 days were entered. Additionally, a duplicate period of Office delay of 43 days was entered. The duplicate periods of Office delay and applicant delay will be removed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is FORTY-EIGHT (48) days (242 (108 + 91 + 43) days of PTO delay, reduced by 194 (64 + 2 + 11 + 5 + 14 + 61 + 4 + 33) days of Applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is thereby forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and if applicable, for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Anthony Knight
Supervisor
Office of Petitions

Encl: Revised PALM Calculation

PALM INTRANET

PTA Calculations for Application: 10/677092

Application Filing Date:	09/30/2003	PTO Delay (PTO):	285
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	267
Post-Issue Petitions:	0	Total PTA (days):	48
PTO Delay Adjustment:	30		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
162	03/26/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	30		
155	09/21/2009	MAIL NOTICE OF ALLOWANCE			
154	09/17/2009	ISSUE REVISION COMPLETED			
153	08/08/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
152	08/08/2009	DOCUMENT VERIFICATION			
151	08/08/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
150	08/04/2009	NOTICE OF ALLOWABILITY			
149	07/20/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
148	07/20/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
147	07/28/2009	DATE FORWARDED TO EXAMINER			
146	07/20/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)			
145	07/28/2009	DISPOSAL FOR A RCE / CPA / R129			
144	07/20/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
143	07/20/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
142	06/22/2009	EXPORT TO INITIAL DATA CAPTURE			
141	06/17/2009	MAIL NOTICE OF ALLOWANCE			
141	06/17/2009	MAIL NOTICE OF ALLOWANCE			
140	06/17/2009	ISSUE REVISION COMPLETED			
140	06/17/2009	ISSUE REVISION COMPLETED			
139	06/17/2009	DOCUMENT VERIFICATION			
139	06/17/2009	DOCUMENT VERIFICATION			
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138	06/17/2009	COMPLETED		
138	06/17/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED		
137	06/09/2009	NOTICE OF ALLOWABILITY		
137	06/09/2009	NOTICE OF ALLOWABILITY		
136	05/27/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
136	05/27/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
135	06/02/2009	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)		
135	06/02/2009	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)		
134	05/27/2009	REFERENCE CAPTURE ON IDS		
134	05/27/2009	REFERENCE CAPTURE ON IDS		
133	05/27/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
133	05/27/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
132	05/29/2009	DATE FORWARDED TO EXAMINER		
132	05/29/2009	DATE FORWARDED TO EXAMINER		
131	05/27/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)		
131	05/27/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)		
130	05/29/2009	DISPOSAL FOR A RCE / CPA / R129		
130	05/29/2009	DISPOSAL FOR A RCE / CPA / R129		
129	05/29/2009	CORRESPONDENCE ADDRESS CHANGE		
129	05/29/2009	CORRESPONDENCE ADDRESS CHANGE		
128	05/27/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
128	05/27/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
127	05/27/2009	WORKFLOW - REQUEST FOR RCE - BEGIN		
127	05/27/2009	WORKFLOW - REQUEST FOR RCE - BEGIN		
126	03/03/2009	EXPORT TO INITIAL DATA CAPTURE		
126	03/03/2009	EXPORT TO INITIAL DATA CAPTURE		
125	02/27/2009	MAIL EXAMINER'S AMENDMENT		
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124	02/27/2009	MAIL NOTICE OF ALLOWANCE	43	107

124	02/27/2009	MAIL NOTICE OF ALLOWANCE	43		107
123	02/26/2009	ISSUE REVISION COMPLETED			
123	02/26/2009	ISSUE REVISION COMPLETED			
116	10/21/2008	EXAMINER'S AMENDMENT COMMUNICATION			
116	10/21/2008	EXAMINER'S AMENDMENT COMMUNICATION			
114	10/15/2008	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
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113	10/14/2008	DOCUMENT VERIFICATION			
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111	10/14/2008	NOTICE OF ALLOWABILITY			
111	10/14/2008	NOTICE OF ALLOWABILITY			
110	09/15/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
110	09/15/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
109	09/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	0	107	
109	09/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	0	107	
108	10/09/2008	DATE FORWARDED TO EXAMINER			
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107	09/15/2008	RESPONSE AFTER NON-FINAL ACTION	33	104	
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106	09/15/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
105	09/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
105	09/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
104	05/13/2008	MAIL NON-FINAL REJECTION			
104	05/13/2008	MAIL NON-FINAL REJECTION			
103	05/12/2008	NON-FINAL REJECTION			

103	05/12/2008	NON-FINAL REJECTION			
102	04/21/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
102	04/21/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
101	04/21/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
101	04/21/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
100	05/01/2008	DATE FORWARDED TO EXAMINER			
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99	04/21/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)	4	94	
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98	05/01/2008	DISPOSAL FOR A RCE / CPA / R129			
98	05/01/2008	DISPOSAL FOR A RCE / CPA / R129			
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97	04/21/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
96	04/21/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
96	04/21/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
95	01/21/2008	EXPORT TO INITIAL DATA CAPTURE			
95	01/21/2008	EXPORT TO INITIAL DATA CAPTURE			
94	01/17/2008	MAIL NOTICE OF ALLOWANCE			
94	01/17/2008	MAIL NOTICE OF ALLOWANCE			
93	01/16/2008	ISSUE REVISION COMPLETED			
93	01/16/2008	ISSUE REVISION COMPLETED			
92	01/16/2008	DOCUMENT VERIFICATION			
92	01/16/2008	DOCUMENT VERIFICATION			
91	01/16/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
91	01/16/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
90	01/07/2008	NOTICE OF ALLOWABILITY			
90	01/07/2008	NOTICE OF ALLOWABILITY			
89	11/29/2007	DATE FORWARDED TO EXAMINER			
89	11/29/2007	DATE FORWARDED TO EXAMINER			
88	11/20/2007	RESPONSE AFTER NON-FINAL ACTION	61	85	

88	11/20/2007	RESPONSE AFTER NON-FINAL ACTION	61	85
87	11/20/2007	REQUEST FOR EXTENSION OF TIME - GRANTED		
87	11/20/2007	REQUEST FOR EXTENSION OF TIME - GRANTED		
86	10/04/2007	CASE DOCKETED TO EXAMINER IN GAU		
86	10/04/2007	CASE DOCKETED TO EXAMINER IN GAU		
85	06/20/2007	MAIL NON-FINAL REJECTION		
85	06/20/2007	MAIL NON-FINAL REJECTION		
84	06/18/2007	NON-FINAL REJECTION		
84	06/18/2007	NON-FINAL REJECTION		
83	06/08/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
83	06/08/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
82	06/08/2007	REFERENCE CAPTURE ON IDS		
82	06/08/2007	REFERENCE CAPTURE ON IDS		
81	06/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
81	06/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
80	06/13/2007	DATE FORWARDED TO EXAMINER		
80	06/13/2007	DATE FORWARDED TO EXAMINER		
79	06/08/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		
79	06/08/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		
78	06/13/2007	DISPOSAL FOR A RCE / CPA / R129		
78	06/13/2007	DISPOSAL FOR A RCE / CPA / R129		
77	06/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
77	06/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
76	06/08/2007	WORKFLOW - REQUEST FOR RCE - BEGIN		
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75	03/12/2007	EXPORT TO INITIAL DATA CAPTURE		
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74	03/08/2007	MAIL NOTICE OF ALLOWANCE		
74	03/08/2007	MAIL NOTICE OF ALLOWANCE		
73	03/01/2007	ISSUE REVISION COMPLETED		

72	03/01/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED
71	02/15/2007	NOTICE OF ALLOWABILITY
70	10/24/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED
69	02/08/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED
68	02/08/2007	REFERENCE CAPTURE ON IDS
67.7	02/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED
67	02/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED
66	02/12/2007	DATE FORWARDED TO EXAMINER
65	02/08/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)
64	02/12/2007	DISPOSAL FOR A RCE / CPA / R129
63	02/08/2007	WORKFLOW - REQUEST FOR RCE - BEGIN
62	11/13/2006	EXPORT TO INITIAL DATA CAPTURE
61	11/08/2006	MAIL NOTICE OF ALLOWANCE
60	11/07/2006	ISSUE REVISION COMPLETED
59	11/07/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED
58	11/07/2006	CASE DOCKETED TO EXAMINER IN GAU
57.7	10/24/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED
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56	10/30/2006	NOTICE OF ALLOWABILITY
55	10/10/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED
54	10/10/2006	REFERENCE CAPTURE ON IDS
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53	10/10/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED
52	10/13/2006	DATE FORWARDED TO EXAMINER
51	10/10/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)
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43	06/16/2006	FINISHED INITIAL DATA CAPTURE			
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37	04/24/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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33	01/09/2006	ISSUE REVISION COMPLETED			
32	01/09/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
31	01/09/2006	NOTICE OF ALLOWABILITY			
30	06/20/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
29	07/01/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
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22	07/01/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	06/20/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
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18	03/17/2005	ISSUE REVISION COMPLETED			
17	03/17/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
16	03/15/2005	NOTICE OF ALLOWABILITY			
15	05/26/2004	PRELIMINARY AMENDMENT			
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13	07/08/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
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9	06/10/2004	APPLICATION IS NOW COMPLETE			
8	05/26/2004	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM	64	6	
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6	12/23/2003	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	12/11/2003	CASE CLASSIFIED BY OIPE			
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1	09/30/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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